

## REMARKS

In the Final Office Action dated April 26, 2005, the claims 11-12, 15-17, and 33-38 were restricted as directed to a non-elected invention. Claim 5 was rejected as being indefinite under 35 U.S.C. 112, second paragraph. The remaining claims 1-8, 10, 13-14, 18-25, 27, and 31 were rejected as being obvious over Willson (U.S. Patent No. 5,169,167) in view of Mortvedt (U.S. Patent No. 4,591,178).

## RESTRICTION REQUIREMENT

Claims 11-12, 15-17, and 33-38 have been withdrawn for consideration. However, Applicants reserve the right to pursue these non-elected claims in a future divisional application.

## SECTION 112 REJECTION

Claim 5 has been amended to overcome this rejection.

## SECTION 103 REJECTIONS

The remaining claims 1-8, 10, 13-14, 18-25, 27, and 31 were rejected as being obvious over Willson in view of Mortvedt.

Willson teaches a mechanism for mounting a front fender to a front wheel of an agricultural tractor. See Willson at abstract. The mounting of the front fender to the front wheel allows “the *entire front fender assembly 20* [to] pivotably move with the corresponding wheel assembly 15 relative to the front axle 19.” See Willson at column 3, line 30 (emphasis added).

Mortvedt teaches a fender with a stationary bracket to be mounted to a farm tractor frame using bolts. The fender is “*secured permanently against movement.*” See Mortvedt at column 3, line 25 (emphasis added).

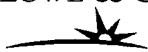
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ACAT-1-1015ROA

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Applicants submit that (1) Willson and Mortvedt may not be combined to support an obviousness rejection and (2) even when combined, Willson and Mortvedt fail to teach each element of the claimed invention.

First, Willson and Mortvedt may not be combined to support an obviousness rejection. Teachings may not be combined to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination *in the references*. See *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990); *Elf Atochem North America, Inc. v. LaRoche Industries, Inc.*, 85 F. Supp.2d 336 (D. Del. 2000); *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878 (Fed. Cir. 1988) (Examiner may not pick and choose among individual elements of assorted prior art references to recreate the claimed invention absent some teaching or suggestion in the references to support the use in the particular claimed combination); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.* (1986) (a reference should be considered as a whole). *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354 (N.D. Ill. 1993), *aff'd* 71 F.3d 1573 (Fed. Cir. 1995) (unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious).

Nothing in Willson teaches, suggests, or motivates combining its movable fender with a reference that teaches attaching the fender to a tractor frame. Indeed, Willson teaches away from such a combination given that it repeatedly and expressly states that the movable fender is to be attached to the front tractor wheel rather than the tractor frame: (1) "...mounting bracket connected to the front wheel..." See Willson at abstract and (2) "...affixed by fasteners 23 to the pivotably moveable wheel assembly 15, to which the steering mechanism 17 is attached to affect the pivotal movement thereof relative to the front axle 19." See Willson at column 3, line 26. The argument for teaching away is strengthened given that the decision to attach the Willson fender to the wheel rather than the frame is not optional, but rather it is a requirement for the invention to operate. Willson states that the reason for the fender being attached to the wheel is to allow the fender to mirror the wheel movements to provide maximum protection from farming

debris. See Willson at column 3, line 30 (“[T]he entire front fender assembly 20 pivotably moves with the corresponding wheel assembly 15 relative to the front axle 19.”) Quite apparently, if the Willson fender was attached to the tractor frame, it would not move with the corresponding wheel assembly relative to the front axle and the invention would be rendered inoperable. See *In re Spinnoble*, 405 F. 2d 578 (CCPA 1969) (references teach away since they would produce a seemingly inoperative device).

Nothing in Mortvedt teaches, suggests, or motivates introducing movable features into its stationary farm tractor fender. Instead, the reference proceeds with an overwhelming number of statements that indicate exactly the opposite: (1) “[A] *stationary bracket* adapted to be mounted to a vehicle frame” See Mortvedt at abstract; (2) “The *stationary bracket* is attached by bolts to the frame” See Mortvedt at column 1, line 57; (3) “Fender 20 comprises two *stationary brackets* 22, 24” See Mortvedt at column 2, line 38; (4) “A pair of brackets 52 engage each of the sleeves 48, 50 and are bolted to the undersurfaces of straps 44, 46 by means of a plurality of bolts 54 ... Bolts 54 also extend through flap 56 so as to secure the flapst 56, the straps 44, 46, and the sleeves 48, 50 together in a *unitary configuration*. Additional bolts 58 may be used to prove *additional securement*” See Mortvedt at column 2, line 55; (5) “Then set screws or bolts 60 are tightened so as to hold the sleeves 48, 50 *against further longitudinal or rotational movement* on shafts 28, 36” See Mortvedt at column 3, line 16; and (6) “[T]hese brackets may be secure *permanently against movement*” See Mortvedt at column 3, line 25. There simply is no suggestion or motivation in Mortvedt to modify its fender from being “permanently secured against movement” to being movable.

”With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a *combination of elements that are themselves mundane* ... Unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious or

anticipated.” *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354 (N.D. Ill. 1993), *aff’d* 71 F.3d 1573 (Fed. Cir. 1995) (emphasis added).

Second, even when Willson and Mortvedt are combined, they fail to teach each and every element of the claimed invention. Claim 1 includes a first and second mounting assembly wherein a all terrain vehicle fender body is adapted to be removably coupled to one of the mounting assemblies. Neither Willson nor Mortvedt discloses multiple mounting assemblies. Willson teaches only a single “arcuate mounting bracket.” See Willson at abstract, Figure 1, Figure 2, and Figure 3. Furthermore, neither Willson nor Mortvedt teach an all terrain vehicle fender body. The American Heritage Dictionary defines an all-terrain vehicle as, “A small, open motor vehicle having one seat and three or more wheels fitted with large tires. It is designed chiefly for recreational use over roadless, rugged terrain.” Both Willson and Mortvedt teach agricultural farm tractors. See Willson at abstract and Mortvedt at column 1, line 43. Agricultural farm tractors do not fit within the definition of an ATV because they are not small, do not have open motors, and are not suited for recreational use over roadless, rugged terrain. Accordingly, claim 1 and its dependent claims 2, 3, 4, 5, and 13 are not obvious over Willson and Mortvedt even if these references were properly combined.

Claim 3 is not obvious for the additional reason that neither Willson nor Mortvedt teach rotation along the length of the tractor. Mortvedt, of course, doesn’t teach any movement whatsoever. Willson, teaches only “an agricultural tractor in which the fender can be positionally adjusted in three separate directions...around the circumference...radial...traverse.” See Willson at column 1, line 34.

Claim 4 is not obvious for the additional reason that neither Willson nor Mortvedt teach using breakaway connectors. Mortvedt, as has been shown, teaches the extensive use of bolts. Bolts are unsuitable as breakaway connectors. Willson, similarly, teaches the use of fasteners to

provide “greater stability between the support bracket 30 and the mounting bracket 22.” See Willson at column 4, line 56.

Claim 5 is not obvious for the additional reason that neither Willson nor Mortvedt teach removably coupling the fender body without tools. Mortvedt states, “When the farmer reaches the field he can quickly detach the fenders merely by removing bolts 60.” See Mortvedt at column 3, line 41. Willson similarly teaches the extensive use of fasteners that require tools for removal. See Figure 2, points 32, 34, 44. Bolts cannot be removed without tools.

Claim 13 is not obvious for the additional reason that neither Willson nor Mortvedt teach a fender body for a rear wheel. Both Willson and Mortvedt are directed towards agricultural farming tractors. The American Heritage Dictionary defines a tractor as, “A vehicle having a powerful gasoline or diesel motor and usually *large, heavily treaded rear tires*, used especially for pulling farm implements or machinery.” (emphasis added). Thus, there is a well-known, significant difference between the front and rear tires, unlike those of an ATV. The difference is so acute that Willson specifically states that its invention is directed only toward “mounting the front fender.” See Willson at abstract. Similarly, Mortvedt depicts the fender installed only on the front tires of the tractor. See Mortvedt at Figure 1, 2.

Claim 44 includes a fender body adapted to cover a wheel of an all terrain vehicle and a mounting assembly that is adjustably located on the frame. First, neither Willson nor Mortvedt teach a fender for an all terrain vehicle as discussed in the claim 1 analysis above. Next, neither reference teaches a mounting assembly that is adjustably located on the frame. Willson’s fender, of course, is not located on the frame: (1) “...mounting bracket connected to the front wheel...” See Willson at abstract and (2) “...affixed by fasteners 23 to the pivotably moveable wheel assembly 15, to which the steering mechanism 17 is attached to affect the pivotal movement thereof relative to the front axle 19.” See Willson at column 3, line 26. Also, recall that the Willson invention teaches away from frame mounting because the purpose of the invention is for the fender to mirror the wheel. Furthermore, Mortvedt does not teach an adjustable mounting

assembly, but rather a stationary bracket that is secured permanently against movement as discussed in the claim 1 analysis. Accordingly, claim 44 and its dependent claims 45, 46, 47, and 48 are not obvious over Willson in view of Mortvedt because these references do not teach every element of the claims.

The dependent claims 45, 46, 47, and 48 parallel the claim 1 dependent claims and are not obvious for the additional reasons set forth for those claims.

Claim 39 includes a fender body adapted to engage an ATV frame at at least two different locations to cover a wheel from different positions. Neither Willson nor Mortvedt teach an ATV or a fender body adapted to engage a frame at at least two different locations to cover a wheel from different positions. First, both Willson and Mortvedt fail to disclose an ATV as discussed for claim 1. Second, neither reference teaches engaging a frame at two different locations to cover a wheel from different positions. Willson does not teach frame mounting as discussed for claim 44. Furthermore, Willson only teaches a single mounting location on the wheel as discussed for claim 1 and clearly depicted in Figure 2. Next, Mortvedt does not teach covering the wheel from multiple positions. Instead, as discussed extensively above, Mortvedt expressly discloses only single mounting position with a stationary bracket that is *secured permanently against movement*. Accordingly, claim 39 and its dependent claims 40, 41, 42, and 43 are not obvious over Willson in view of Mortvedt because the references do not teach every limitation of the claims.

The dependent claims 40, 41, 42, and 43 parallel the claim 1 dependent claims and are not obvious over the references for the additional reasons set forth for those claims.

Claim 18 and its dependent claims are method claims that parallel claim 39 and its dependent claims. Accordingly, claim 18 and its dependent claims are not obvious over Willson in view of Mortvedt for the reasons set forth those claims.

The dependent claims 18 parallel the claim 1 dependent claims and are not obvious for the additional reasons set forth for those claims.

**NEW CLAIMS**

Claims 39-48 are newly presented. No new matter has been added.

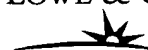
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## CONCLUSION

The Examiner is kindly thanked for the careful attention to the present application. The claims presented are not obvious over Willson in view of Mortvedt for two reasons. First, these references may not be properly combined to support an obviousness rejection because there is nothing in the references themselves that teaches, suggests, or motivates the combination. Instead, they clearly teach away from such a combination. Second, even if the references could be combined, they jointly fail to teach every limitation of the presented claims. Therefore, the Applicants respectfully request withdrawal of the rejections, allowance, and early passage of the claims through issuance. If the Examiner has any questions, the Examiner is invited to contact the Applicants' attorney listed below.

Respectfully submitted,

BLACK LOWE & GRAHAM<sup>PLLC</sup>



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I am the:

☐ Applicant/Inventor.

☒ Assignee of record of the entire interest. See 37 CFR 3.71.  
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

**SIGNATURE of Applicant or Assignee of Record**

Signature

Name

Ole E. Tweet, Vice President, Arctic Cat Inc.

Date

June 1, 2005

Telephone

218-681-9799 x4115

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ Total of \_\_\_\_\_ forms are submitted.

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**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: Arctic Cat Inc.

Application No./Patent No.: Numerous/See Attached Filed/Issue Date: \_\_\_\_\_

Entitled: \_\_\_\_\_

Arctic Cat Inc., a Corporation

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.  
The extent (by percentage) of its ownership interest is \_\_\_\_\_ %

In the patent application/patent identified above by virtue of either:

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OR

B ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

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[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

  
Signature

June 1, 2005  
Date

Ole E. Twest  
Printed or Typed Name

218-681-9799 x4115  
Telephone Number

Vice President  
Title

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# ATTACHMENT (June 1, 2005)

<u>Application No.</u>	<u>New Attorney Docket No.</u>	<u>Assignment</u>	
		<u>Reel</u>	<u>Frame</u>
10/749,320	ACAT-1-1015	015439	0842
11/091,188	ACAT-1-1016	CIP (10/353/281)	
10/369,221	ACAT-1-1017	013639	0227
10/262,756	ACAT-1-1019	013358	0246
10/953,940	ACAT-1-1020	CON (10/290,846)	
10/947,733	ACAT-1-1021	CON (10,262,759)	
10/353,281	ACAT-1-1022	013959	0847
10/283,383	ACAT-1-1023	013683	0293
10/172,531	ACAT-1-1024	013017	0869
10/373,601	ACAT-1-1025	013681	0368
10/695,301	ACAT-1-1026	015112	0861
10/290,842	ACAT-1-1027	013685	0583
10/172,577	ACAT-1-1028	013246	0472 (Patent No. 6,843,603)
10/215,785	ACAT-1-1029	013190	0870 (Patent No. 6,890,010)
10/224,858	ACAT-1-1030	013216	0432
10/290,847	ACAT-1-1031	013685	0555
10/439,640	ACAT-1-1032	014366	0702
09/843,587	ACAT-1-1033	CIP (09/520,101)	
10/290,844	ACAT-1-1034	013666	0930
10/793,105	ACAT-1-1035	CON (10/346,740)	
10/008,455	ACAT-1-1036	012962	0511
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10/290,946	ACAT-1-1038	013489	0928